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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/726,245	11/30/2000	Allan E. Brockenbrough	782.1098/JCG	1046

21171 7590 04/12/2004

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EXAMINER

NGUYEN, DAVID Q

ART UNIT	PAPER NUMBER
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2681

DATE MAILED: 04/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/726,245

Applicant(s)

ALLAN E. BROCKENBROUGH ET  
AL

Examiner

David Q Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 30 November 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 25-45 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5 and 6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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## DETAILED ACTION

### *Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-24, drawn to a wireless telephone apparatus having voice mode and data mode. User can play game using data mode, classified in class 455, subclass 552.
  - II. Claims 25-45, drawn to a first device operated by a first competitor sending a request and a competitor list to a second device operated by a second competitor through a communication network, classified in class 463, subclass 11.
2. Inventions I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are one invention to deal with playing game using a wireless communication system, and the other one not to.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with Mr. John Garvey (Reg. No. 28607) on April 07, 2004 a provisional election was made with traverse to prosecute the invention of group I, claims 1-24. Affirmation of this election must be made by applicant in replying to this Office action.

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Claims 25-45 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1,3,6-9,11-12,14-19 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tomcik et al. (US 6317607) In view of Sinclair et al (US 6527641).

Regarding claim 1, Tomcik et al disclose a wireless telephone apparatus, comprising: a first wireless telephone having switchable data and voice mode communication capabilities (see col. 2, lines 50-57), and a wireless telephone communication system communicating with said first wireless telephone, recognizing when said telephone is in data mode at a time when a voice telephone call to said first wireless telephone is being attempted, and sending a notification of the voice telephone call to said first wireless telephone informing a user of said first wireless telephone about the voice telephone call (see col. 8, lines 35-47). Tomcik et al are silent to mention said data mode including a competitive activity mode involving communication with a second wireless telephone to engage in a competitive activity. However, Sinclair et al disclose data mode including a competitive activity mode involving communication with a second wireless telephone to engage in a competitive activity (see col. 5, lines 30-47). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to

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provide the above teaching of Sinclair et al to Tomcik et al so that user can accept an incoming call while playing game.

Regarding claim 3, the apparatus of Tomcik et al in view of Sinclair et al also discloses wherein said competitive activity is a game (see col. 5, lines 30-47 of Sinclair et al.).

Regarding claim 6-8, the apparatus of Tomcik et al in view of Sinclair et al is silent to disclose wherein said competitive activity is a round-robin activity; wherein said competitive activity is a turn-taking activity; wherein the turn-taking activity is a game. However, Examiner takes official notice that competitive activity being a round-robin activity, a turn-taking activity and the turn-taking activity being a game is well known in the art in order to provide users more fun. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the above teaching to the apparatus of Tomcik et al in view of Sinclair et al to so that user can enjoy the game.

Regarding claims 9, ~~and~~ 19 and 21, Tomcik et al disclose a method and a computer readable storage controlling a computer comprising: determining whether a first multimode communication device is in a data mode when a voice telephone call to a user of the first multimode communication device is attempted; and informing the user of the first multimode communication device about the voice telephone call (see col. 2, lines 50-57 and col. 8, lines 35-47). Tomcik et al are silent to mention the data mode is a sequential participation mode and a competitive activity mode involving communication with a second multimode communication device to engage in a competitive activity. However, Sinclair et al disclose data mode is a sequential participation mode and a competitive activity mode involving communication with a second multimode communication device to engage in a competitive activity (see col. 5, lines

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30-47). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the above teaching of Sinclair et al to Tomcik et al so that user can accept an incoming call while playing game.

Regarding claims 11-12, the method of Tomcik et al. in view of Sinclair et al. also discloses wherein the first multimode communication device is a wireless communication device (see abstract of Tomcik et al.); wherein the wireless communication device is a wireless telephone (see col. 2, lines 50-53 of Tomcik et al.).

Regarding claim 14, the method of Tomcik et al in view of Sinclair et al is silent to disclose wherein the competitive activity is a game (see col. 5, lines 30-47 of Sinclair et al.).

Regarding claims 15-18, the method of Tomcik et al in view of Sinclair et al is silent to disclose wherein the competitive activity is a debate; wherein the competitive activity is a fantasy sports draft; wherein the competitive activity is a round-robin activity; wherein the competitive activity is a turn-taking activity.

However, Examiner takes official notice that competitive activity being a debate, a round-robin activity, a turn-taking activity and a fantasy sports draft is well known in the art in order to provide users more fun. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the above teaching to the apparatus of Tomcik et al in view of Sinclair et al so that user can enjoy the game.

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6. Claims 2,4-5 and 10,13,20,22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tomcik et al. (US 6317607) in view of Sinclair et al (US 6527641) and further in view of Perlman et al (US 6614890).

Regarding claim 2, the wireless telephone apparatus of Tomcik et al. in view of Sinclair et al. is silent to mention wherein said wireless telephone communication system sends a notification to the second wireless telephone if the user of said first wireless telephone accepts the voice telephone call. However, Perlman et al. disclose a telephone communication system sends a notification to the second wireless telephone if the user of said first wireless telephone accepts the voice telephone call (see col. 2, lines 8-21). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the above teaching of Perlman et al to the telephone apparatus of Tomcik et al in view of Sinclair et al so that user can avoid losing an incoming call while playing game.

Regarding claims 4-5, the wireless telephone apparatus of Tomcik et al. in view of Sinclair et al. is silent to mention wherein said wireless telephone communication system suspends the competitive activity while the user of said first wireless telephone is taking the voice telephone call; wherein said wireless telephone communication system drops said first wireless telephone from the competitive activity when the user of said first wireless telephone accepts the voice telephone call. However, Perlman et al. disclose the telephone communication system suspends the competitive activity while the user of said first wireless telephone is taking the voice telephone call; wherein said wireless telephone communication system drops said first wireless telephone from the competitive activity when the user of said first wireless telephone accepts the voice telephone call (see col. 2, lines 8-21). Therefore, it would have been obvious to

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one of ordinary skill in the art at the time the invention was made to provide the above teaching of Perlman et al to the telephone apparatus of Tomcik et al in view of Sinclair et al so that user can avoid losing an incoming call while playing game.

Regarding claims 10,20 and 22, the method and the computer readable storage of Tomcik et al. in view of Sinclair et al. is silent to mention determining whether a first multimode communication device is in a data mode which is a competitive activity mode involving communication with a second multimode communication device to engage in a competitive activity, when a voice telephone call to a user of the first multimode communication device is attempted; and informing the user of the first multimode communication device about the voice telephone call. However, Perlman et al. disclose this limitation (see explanation in claim 10). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the above teaching of Perlman et al to the method of Tomcik et al in view of Sinclair et al. so that user can avoid losing an incoming call while playing game.

Regarding claim 13, the Tomcik et al. in view of Sinclair et al. is silent to disclose suspending the competitive activity while the user of the first multimode communication device is conducting the voice telephone call; and restarting the competitive activity mode when the user of the first multimode communication device has completed the voice telephone call.

However, Perlman et al. disclose suspending the competitive activity while the user of the first multimode communication device is conducting the voice telephone call; and restarting the competitive activity mode when the user of the first multimode communication device has completed the voice telephone call (see col. 2, lines 8-21). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the above



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teaching of Perlman et al to the telephone apparatus of Tomcik et al in view of Sinclair et al. so that user can avoid losing an incoming call while playing game.

Regarding claims 23-24, the method of Tomcik et al. in view of Sinclair et al. also discloses wherein the sequential participation activity is a competitive activity (see explanation in claim 21); wherein the competitive activity is a game (see explanation in claim 14).

### *Conclusion*

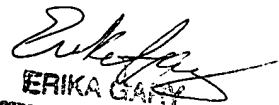
7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Q Nguyen whose telephone number is 703-605-4254. The examiner can normally be reached on 8:30AM-5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Erika A Gary can be reached on 703-308-0123. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

DN

David Nguyen

  
ERIKA GARY  
PATENT EXAMINER